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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/734,377	12/12/2003	Joel R. Weiss	S01.12-1009/STL 11567	9761

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EXAMINER

TUPPER, ROBERT S

ART UNIT PAPER NUMBER

2627

DATE MAILED: 11/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/734,377	Applicant(s) WEISS ET AL.	
	Examiner Robert S. Tupper	Art Unit 2627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 September 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) 13-23, 29 and 33-40 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12, 24-28, and 30-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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1. Applicant's election with traverse of the species of figure 13, indicating claims 1-12, 24-28, and 30-32 to read thereon, in the reply filed on 9/11/06 is acknowledged.

The traversal is on the ground(s) that (1) claims 1-40 are all consistent with and applicable to each of the species, (2) the subject matter of each of claims 1-40 is either explicitly depicted or plainly applicable to the depicted species, (3) many of the claims have overlapping scope, and (4) there is no serious burden. This is not found persuasive because all are in error.

Concerning (1) and (2), the species of elected figure 13 is clearly limited to the features of the air bearing surface.

Concerning (3), this is simply in error. All sliders are associated with some suspension, and conversely, all suspensions are associated with some slider. This does not constitute "overlap".

Concerning (4), there clearly is a serious burden produced by a disclosure and claim set presenting 14 different species, broken down into two different groups of slider and suspension features.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 13-23, 29, and 33-40 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 9/11/06.

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 9, 25, 26, and 30 are rejected under 35 USC 112, first and second paragraphs, as the claimed invention is not described in such full, clear, concise, and exact terms as to enable any person skilled in the art to make and use the same, and/or for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

Claim 9 recites that the vertical stabilizer is a longitudinal fin.

The disclosure clearly indicates that the vertical stabilizer is a surface that is not longitudinal.

This claim is inadequately disclosed under 112 par.1 if read literally that the vertical stabilizer is longitudinally located.

Alternatively, this claim is indefinite and misdescriptive under 112 par.2 for failing to indicate that the longitudinal fin is a separate element in addition to the vertical stabilizer.

Claims 25 and 26 recite that the head is an MR head adapted for either perpendicular (claim 25) or longitudinal (claim 26) recording. MR heads are not recording heads.

These claims are inadequately disclosed under 112 par.1 if read literally to require the MR head to record.

Alternatively, these claims are indefinite and misdescriptive under 112 par.2 for inaccurately stating the function of the MR head.

Claim 30 recites that the "means for exploiting" can be located on "any face of the slider".

The disclosure is clearly limited to an aerodynamic feature that is located on the trailing end of the slider surface facing the medium.

This claim is inadequately disclosed under 112 par.1 because there is no disclosure of locating this means literally "on any surface of the slider".

Alternatively, this claim is indefinite and misdescriptive under 112 par.2 for not accurately reciting the location involved.

6. Claims 2- 12, 27, 28, and 30-32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 2, 27, and 28 the term "minimize" is a relative term which renders these claims indefinite. The term "minimize" is not defined by the claim, the specification does

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not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

In both claims 3 and 12, the recitation "configured such that" is indefinite and incomplete. These claims merely recite functional results without reciting the structural features that provide such.

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

8. Claims 1, 24, 27, and 30-32 are rejected under 35 U.S.C. 102(a) as being clearly anticipated by KOHIRA et al (6,628,480).

Note especially figures 1, 2, and 15. KOHIRA et al shows an assembly with a suspension (20) which includes a gimbal (22) mounting a slider (1) having a vertical stabilizer (12) located at the trailing end, the vertical stabilizer includes two opposing sweepback surfaces (not numbered). The aerodynamic surface of the slider further includes longitudinal fins (7,8).

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 2-12, 25, 26, and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over KOHIRA et al (6,628,480).

KOHIRA et al shows a slider and suspension substantially as claimed.

KOHIRA et al differs in not specifying any details of: (A) the gimbal (re claims 2 and 28), or (B) the head (re claims 25 and 26).

Concerning (A), it would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize any known gimbal. The motivation is as follows: one of ordinary skill in the art would use any known gimbal were no specific structure was disclosed. Note that Applicant acknowledges that known gimbals provide for some rotation of the slider (see page 6 lines 18-20 of the specification). These claims do not define the amount of movement involved.

Concerning (B), it would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize an MR read head in KOHIRA et al. The motivation is as follows: KOHIRA et al simply does not specify what type of head is used. One of ordinary skill in the art would utilize any known head where none was specified. Note that Applicant acknowledges that MR heads are known and commonly used in this environment.

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

KANG (6,680,821) is cited for another showing of a suspension/slider assembly where the slider has a vertical stabilizer as recited in the elected claims. All of the elected claims do not define over KANG. It has not been applied to avoid undue multiple rejections. Applicant must define over KANG in responding to this rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert S. Tupper whose telephone number is 571-272-7581. The examiner can normally be reached on Mon - Fri, 6:30 AM - 4:00 PM (first Fri off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hoa Nguyen can be reached on 571-272-7579. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Robert S Tupper

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Primary Examiner
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